



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,659	10/08/2003	Kit S. Lam	8141/11803	9161

7590 05/23/2005

Audrey A. Millemann
Weintraub Genshlea Chediak Sproul
11th Floor
400 Capitol Mall
Sacramento, CA 95814

EXAMINER

WESSENDORF, TERESA D

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/682,659	Applicant(s) LAM, KIT	
	Examiner T. D. Wessendorf	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicants' election of Group I (claims 1-4) in the reply filed on 2/22/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Pursuant to a telephonic conversation on February 4, 2005, Applicants also request rejoinder of group V (Claim 8) and Group VI (Claim 9) into Group 1. On a telephonic conversation on February 14, 2005, applicants further provisionally elect the genus of Claim 1 in which the first "X" (i.e., "X," in a ligand having the chemical structure of (cXIGXGXXc) is a D-amino acid, and further provisionally elect the species c-d-G-Phg-G-P-F-c, identified on pg. 13, line 15, of the specification. Claim 5 (designated Group II), Claim 6 (designated Group III), and Claim 7 (designated Group IV) are hereby withdrawn without prejudice for presentation in a later co-pending divisional application.

In reply to applicants' request of rejoinder of Claims 8 and 9, these claims are drawn to different genus(subgenus) that contain numerous species.

Claims 5-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected

Art Unit: 1639

invention and species, there being no allowable generic or linking claim. Election was made **without** traverse.

Status of Claims

Claims 1-9 are pending

Claim 5-9 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

Claims 1-4 are under examination.

Specification

The disclosure is objected to because of the following informalities: it is unclear as to what the small letter e.g., d, in the species on e.g., page 13, line 15. Also, the acronyms e.g., "bug", "pra" and so forth as listed in e.g., Example 3. Applicants are requested to specifically recite what the small letters and acronyms stand for.

Appropriate correction is required.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1639

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

To satisfy a written description requirement for a claimed genus a sufficient description of a representative number of species by actual reduction to practice or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. A representative number of species means that the species, which are adequately described, are representative of the entire genus.

Art Unit: 1639

The specification, specifically the Examples, describes a ligand of definite structure for the claimed genus wherein each of the variable X is a specific amino acid. There is no other disclosure, by definition or structure, of the huge scope of the claimed modified or unnatural amino acids. The claimed modified amino acid(s), alone, would include a huge scope of any amino acids modified that the N or C or mid-part of the residue with any kind of moiety, singly or in combinations. The specification does not describe the kind of either the unnatural or modified residue(s) in the peptide sequence that function as a ligand specific for any type of cancer cells. The art (peptide) in which applicants is working is inherently unpredictable. It is not possible to predict that even with a predetermined sequence the amino acid that can be modified, singly or in combination, to reliably predict a ligand with specificity to a cancer cell. It is generally known that there are still no rules that have emerged that allow structure to be related to sequence in any simple fashion (even as applied to the actual compounds). See Liu et al (Jrnl. of the American Chemical Society, the abstract). In biotechnological invention one cannot necessarily claim a genus after only describing a specific species because there may be unpredictability in the results obtained from species other than those specifically described. One may not

Art Unit: 1639

preempt an unduly large field by the expedient of making broad prophetic statements in the specification and claim unless the accuracy of such statements is sufficiently supported by well-established chemical principles or by sufficient number of examples. Applicants, at the time of filing, are deemed to have not invented species sufficient to constitute the genus by virtue of having disclosed a single species when the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed. In re Curtis, 354 F.3d 1347, 1358, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004).

Claim Rejections - 35 USC § 112

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 1 and 3 are unclear as to the differentiating characteristic(s), if any, between an "unnatural" and a "modified" amino acid, especially in the absence of positive differentiation in the specification. Also, these claims are drawn to the same ligand except for the claimed function

Art Unit: 1639

recited in the preamble, which is accorded, little or no weight as not affecting the compound.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 6,670,142 ('142 Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed ligand is similar to the ligand in the '142. The instant claimed ligand encompasses the ligand of the '142 patent. The instant ligand includes "modified" amino acids. However, said "modified" amino acid would obviously be covered by the '142 unnatural amino acids. [The instant

Art Unit: 1639

specification does not define a differentiating characteristic of a modified from an unnatural amino acid.]

No claim is allowed.

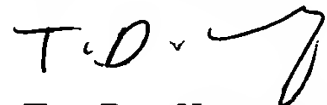
[Note: the Liu reference is not included in the instant application since a copy has already been forwarded to applicants in application S.N. 10/032,678.]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571) 272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571 273-8300.

Art Unit: 1639

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. D. Wessendorf
Primary Examiner
Art Unit 1639

tdw
May 16, 2005